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Filing date: **05/26/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92042991
Party	Defendant Elle Belle, LLC Elle Belle, LLC 1020 6th Avenue New York, NY 10018
Correspondence Address	BALRAM KAKKAR, ESQ. KAKKAR & KADISH 261 MADISON AVENUE, 25TH FLOOR NEW YORK, NY 10016 hui@kakkarkadish.com
Submission	Opposition/Response to Motion
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Signature	/HUI RI KIM/
Date	05/26/2006
Attachments	response to P's summary judgment motion with affidavits.pdf (14 pages) (771027 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 2,657,739

Registered December 19, 2002

Trademark ELLE BELLE

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Hachette Filipacchi Presse,	:	
	:	
Petitioner,	:	Cancellation No. 92042991
	:	
-v-	:	
	:	
Elle Belle, LLC	:	
	:	
Respondent.	:	
-----	X	

**RESPONDENT'S RESPONSE TO PETITIONER'S
SUMMARY JUDGMENT MOTION**

Respondent Elle Belle LLC ("Respondent") hereby responds to Petitioner Hachette Filipacchi Presse's ("Petitioner") Motion for Summary Judgment and Memorandum of Law in Support Thereof.

PRELIMINARY STATEMENT

The basis for Petitioner's summary judgment motion is its allegation that Respondent's President Paramjit Singh ("Mr. Singh") committed fraud in obtaining registration of Respondent's mark ELLE BELLE, Registration No. 2657739, by signing and submitting a trademark application that stated Respondent was using its mark ELLE BELLE in connection with women's, men's and children's clothing, namely, shirts, blouses, dresses, evening wear, skirts, trousers, vests, jerseys, pants, pajamas, t-shirts, socks and stockings, singlets, corsets, garters, underpants, petticoats, hats, head scarves, neckties, raincoats, overcoats, great coats, bathing suits, sports overalls, wind resistant jackets and ski pants, although the mark was only being used in connection with women's clothing, namely, shirts, blouses, dresses, evening wear,

skirts, jerseys, pants, corsets and head scarves. However, Mr. Singh did not commit fraud in obtaining Respondent's registration. Any inconsistency between the goods listed in the application and goods with which Respondent used its ELLE BELLE mark is a result of inadvertent error and/or oversight and as such Petitioner's summary judgment motion should be denied in its entirety.

ARGUMENT

A party is entitled to summary judgment only if it establishes that there are no genuine issues as to any material facts and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). Any doubts as to any factual issues in dispute must be viewed in the light most favorable to the defendant. *See Old Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

In order to establish fraud upon the United States Trademark Patent and Trademark Office ("USPTO"), defendant's statements must have been willful, in bad faith and with the intent to obtain something to which it is not otherwise entitled. Crown Wallcovering Corp. v. Wall Paper Mfgs. Ltd., 188 USPQ 141 (TTAB 1975). False statements are not fraudulent if they are inadvertent, negligent omissions, or if they result from a misunderstanding. *See American-Speech-Language-Hearing Assn. v. National Hearing Aid Society*, 224 USPQ 798, 805 (TTAB 1984); Rogers Corp. v. Fields Plastics & Chemicals, Inc. 176 USPQ 280, 283 (TTAB 1972). A fraud allegation must also be proven "to the hilt" with clear and convincing evidence. Smith International, Inc. v. Olin Corporation, 209 USPQ 1033, 1043-44 (TTAB 1981).

Mr. Singh did not commit fraud as his statements on the application for registration of Respondent's mark ELLE BELLE were not made willfully, in bad faith or with

the intent to obtain something to which Respondent was not entitled. In February of 2000, Mr. Singh procured Balram Kakkar, Esq. as his attorney in order to obtain a trademark registration for Respondent's mark ELLE BELLE. Mr. Singh and Mr. Kakkar discussed the details of the application whereby Mr. Singh informed Mr. Kakkar that Respondent was using its mark ELLE BELLE in connection with women's clothing, including shirts, blouses, dresses, evening wear, skirts, jerseys, pants, corsets and head scarves, and *would likely also use in the future* it in connection with men's and children's clothing, and additional women's clothing, including trousers, vests, pajamas, t-shirts, socks and stockings, singlets, garters, underpants, petticoats, hats, neckties, raincoats, overcoats, great coats, bathing suits, sports overalls, wind resistant jackets and ski pants. Following this discussion, Mr. Kakkar prepared the application and, misunderstanding part of his conversation with Mr. Singh, represented the items that Mr. Singh informed him that Respondent *intended* on selling in connection with Respondent's mark, as those with which Respondent was currently using its ELLE BELLE mark.

When forwarding the application to Mr. Singh for his signature, Mr. Kakkar did not personally review the classification of goods listed therein with Mr. Singh, nor any other part of the application. Mr. Singh was unaware that the application represented that Respondent was at that time using its mark ELLE BELLE in connection items that Respondent had only intended to sell under its mark. Mr. Singh is an immigrant whose primarily language is Punjabi and for whom English is a second language. Understandably, Mr. Singh has additional difficulty in comprehending legal documents, including trademark application and related papers, which are often difficult to comprehend even for native English speakers. Mr. Singh's misrepresentation was also the result of an administrative error. Having no knowledge of the process for obtaining a trademark registration, or for any other legal procedures for that matter, Mr. Singh was

unaware that a trademark application could only list those items that are being sold at that time under the applicant's mark. Mr. Singh's confusion and lack of knowledge was evident during his deposition where he readily stated that Respondent had not used its mark in connection with men's and children's clothing, and certain women's clothing including trousers, vests, pajamas, t-shirts, socks and stockings, singlets, corsets, garters, underpants, petticoats, hats, neckties, raincoats, overcoats, great coats, bathing suits, sports overalls, wind resistant jackets and ski pants.

Throughout this cancellation proceeding, Mr. Singh has had difficulty understanding the cancellation process and has had difficulties communicating with his attorneys due to his lack of fluency in the English language. On numerous occasions during his deposition, attorneys for both parties had to repeat or rephrase the questions posed to Mr. Singh because he experienced difficulty understanding and responding to the questions posed. On several occasions Mr. Singh was asked by his attorney to repeat his answers as it was apparent that Mr. Singh was misstating his responses due to the language barrier.

Mr. Singh's actions also do not constitute fraud because it is highly unlikely that Respondent would not have obtained registration of its mark had the application been submitted listing the more limited articles of women's clothing (*see Crown Wallcovering Corp. v. Wall Paper Mfgs. Ltd.*, 188 USPQ 141 (TTAB 1975) (Fraud upon the USPTO constitutes the willful withholding of material information which, if disclosed, would have resulted in the disallowance of the registration). Moreover, the answer to whether Mr. Singh committed fraud lies in his intent, and the question of intent is generally not suited to disposition on summary judgment. *KangaROOS U.S.A. Inc. v. Caldor, Inc.*, 778 F.2d 1571, 1575, 228 USPQ 32, 34-35 (Fed. Cir. 1985) (citing *Pfizer, Inc. v. International Rectifier Corp.*, 538 F. 2d 180, 185, 190 USPQ 273.

277 (8th Cir. 1976), cert. denied, 429 U.S. 1040, 97 S.Ct. 738, 50 L.Ed.2d 751 (1977).

In its summary judgment motion, Petitioner alleges that (1) Respondent never denied Hachette's allegations in its Amended Petition to Cancel that Respondent's mark should be cancelled due to fraud; (2) Respondent's ELLE BELLE registration would not have issued but for Respondent's misrepresentation; (3) Mr. Singh admitted that he knew that his declaration was false when he signed it in March 2000; and (4) Respondent's failure to amend its registration to delete the goods upon which it failed to use its mark ELLE BELLE demonstrates Respondent's fraudulent intent. As to the first item, Respondent responded to Petitioner's allegation by Answer dated and filed on May 4, 2006. As to the second item, Petitioner failed to provide any evidence that Respondent would not have been granted registration for its ELLE BELLE mark but for the alleged misrepresentation. In fact, as previously stated, it is highly unlikely that the registration would have been rejected had it only listed the limited description of women's clothing. As to the third item, Mr. Singh never admitted that he knowingly signed a false declaration in his deposition testimony. He only stated in his deposition that on March 6, 2000, he knew Respondent was not using the mark in connection with some of the items that were mentioned by opposing counsel in her preceding questions during the deposition. See attached, Exh. B. Singh Dep at 194:3-14. Finally, as to the fourth allegation, Respondent will shortly submit an amendment to update its current registration to reflect only those goods that bear Respondent's mark.

CONCLUSION

For the foregoing reasons, the Board should deny Petitioner's motion for summary judgment.

Dated: May 26, 2006

ELLE BELLE LLC

By: 

Hui Ri Kim, Esq.

Kakkar & Associates

261 Madison Avenue, 25th Fl.,

New York, N.Y. 10016

(212) 867 3065

Page 194

1 P. Singh

2 A. Yes.

3 Q. It is dated March 6th, 2000.

4 A. Yes.

5 Q. Is that when you signed the

6 document?

7 A. Yes.

8 Q. You knew, in March of 2000, that

9 Elle Belle was not using its mark with respect

10 to the goods we just discussed -- the

11 trousers, and the bathing suits --

12 A. Yes, I knew.

13 Q. You knew that?

14 A. Yes.

15 Q. On page 91 of that packet, it is a

16 document entitled "notice of publication."

17 A. Yes.

18 Q. Under 12A. Do you have any

19 understanding of what that document is or

20 means?

21 A. Let me read it.

22 Q. Do you know what a notice of

23 publication is?

24 A. Yes, I got it. Yes, I know.

25 Q. What is that?

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1 P. Singh

2 A. It means, I believe, that the

3 Department of Commerce, for this notice.

4 Q. The Patent and Trademark Office?

5 A. The Patent and Trademark Office.

6 Q. The Department of Commerce. Go

7 ahead, sorry.

8 A. The notice that they are going to, I

9 believe, approve this trademark.

10 Let me read it.

11 Q. Okay.

12 MS. KIM: I guess your question was,

13 without reading this, do you just, in

14 general, know what a notice of

15 publication is?

16 THE WITNESS: The Elle Belle mark --

17 MS. KIM: Do you know what that is?

18 THE WITNESS: Yes.

19 MS. KIM: What is that?

20 A. That is my trademark.

21 MS. WHITING: Let me try to fix

22 that.

23 Q. I will ask you this question.

24 A. Okay.

25 Q. Do you know what a notice of

Page 196

1 P. Singh

2 publication is? It is fine if you don't know

3 what a notice of publication is. I am just

4 asking if you know that?

5 A. I don't know what a notice is. I

6 can see it is something about the Elle Belle

7 mark.

8 Q. I will represent to you that a

9 notice of publication is when a mark is

10 published for possible opposition by another

11 party --

12 A. Okay.

13 Q. So, if you look at this document,

14 number 91, it says the publication date is

15 September 17th, 2002.

16 A. Yes.

17 Q. Do you know -- is there anything

18 about the notice of publication, after the

19 mark was published for opposition, after that

20 after September, 2002, and you don't have

21 to --

22 I will withdraw that question.

23 I will just take the date, after

24 September, 2002 --

25 A. August 28th, 2002?

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1 P. Singh

2 Q. That is August 28th. That is the

3 date of the notice and the actual publication

4 date is September, 2002, which is number 4.

5 A. All right.

6 Q. If you look at number 4 on that.

7 A. Yes.

8 Q. I will restate the question, so that

9 it is understandable. Sorry.

10 I am just looking at that date,

11 September, 2002, which is when the mark was

12 published for possible opposition.

13 Taking that date, September, 2002,

14 is there anything that Elle Belle, the

15 business Elle Belle LLC did differently after

16 September, 2002 with respect to expanding or

17 advertising or anything that, is there

18 anything that it did differently between then

19 and the time that Hachette actually filed its

20 petition to cancel, which was in 2004?

21 A. No.

22 MS. WHITING: I will mark this as

23 Petitioner's Exhibit 19.

24 (Petitioner's Exhibit 19,

25 document Bates No. 1, marked for

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-v-	:	
	:	
Elle Belle, LLC	:	
	:	
Respondent.	:	
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**AFFIDAVIT OF PARAMJIT SINGH IN SUPPORT OF RESPONDENT'S RESPONSE
TO PETITIONER'S SUMMARY JUDGMENT MOTION**

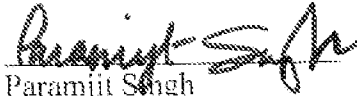
Paramjit Singh, being duly sworn deposes and says:

1. I am the President of Respondent Elle Belle LLC ("Respondent") and submit this affidavit in support of Respondent's response to Petitioner's summary judgment motion.
2. The basis for Petitioner's motion is its allegation that I committed fraud in obtaining registration of Respondent's mark ELLE BELLE by signing and submitting a trademark application stating that Respondent was using its mark ELLE BELLE in connection with women's, men's and children's clothing, namely, women's, men's and children's clothing, namely, shirts, blouses, dresses, evening wear, skirts, trousers, vests, jerseys, pants, pajamas, t-shirts, socks and stockings, singlets, corsets, garters, underpants, petticoats, hats, head scarves, neckties, raincoats, overcoats, great coats, bathing suits, sports overalls, wind resistant jackets and ski pants, although at that time the mark was only being used in connection with women's clothing, namely, shirts, blouses, dresses, evening wear, skirts, jerseys, pants, corsets and head scarves.

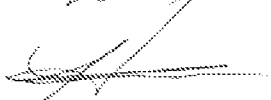
3. In February of 2000, I procured Balram Kakkar, Esq. as my attorney to procure a trademark registration for Respondent's mark ELLE BELLE. I explained to Mr. Kakkar that Respondent was using its mark ELLE BELLE in connection with women's clothing, including shirts, blouses, dresses, evening wear, skirts, jerseys, pants, corsets and head scarves, and *would likely also use in the future* it in connection with men's and children's clothing, and additional women's clothing, including trousers, vests, pajamas, t-shirts, socks and stockings, singlets, corsets, garters, underpants, petticoats, hats, neckties, raincoats, overcoats, great coats, bathing suits, sports overalls, wind resistant jackets and ski pants. However, it is my understanding that Mr. Kakkar misunderstood and was under the impression that Respondent was using its mark in connection with all of the goods mentioned by me, including those that I expressed only a future intent to use.
4. When signing the application, I was completely unaware that the application represented that I was currently using the mark in connection with men's and children's clothing in addition to women's clothing. I believe my oversight and/or misunderstanding of the representations in the application is due to the fact that I am an immigrant from Afghanistan and English is my second language, and one in which I have never been formally educated. I also had no experience or background in such legal matters and was completely unfamiliar with the process of obtaining a trademark registration.
5. I had no intent on committing fraud in procuring registration for Respondent's Elle Belle mark. I believed that the application was submitted and the registration acquired listing women's clothing, namely shirts, blouses, dresses, evening wear, skirts, jerseys, pants, corsets and head scarves, as the only category of goods with which the mark ELLE BELLE was being used at that time. I believe this is evident in my deposition where I

readily stated that Respondent was using the mark in connection only with women's clothing.

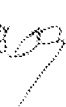
6. I have instructed my attorney to submit an amendment to update Respondent's current registration to reflect only those goods that bear Respondent's mark ELLE BELLE.
7. For the foregoing reasons I request that the Board deny Petitioner's summary judgment motion.


Paramjit Singh

Sworn to before me
this 25th Day of May, 2006



Notary Public

HUI RI KIM
Notary Public, State of New York
No. 02K06131828
Qualified in New York County
Commission Expires Aug. 22, 2009 

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	:	
-v-	:	
	:	
Elle Belle, LLC	:	
	:	
	:	Respondent. :
-----	x	

**AFFIDAVIT OF HUI RI KIM, ESQ. IN SUPPORT OF RESPONDENT'S RESPONSE
TO PETITIONER'S SUMMARY JUDGMENT MOTION**

Hui Ri Kim, Esq., being duly sworn deposes and says:

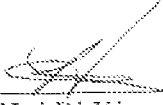
1. I am an associate at Kakkar & Associates, the law firm retained by Respondent in February 2000 to acquire a trademark registration for Respondent Elle Belle LLC's ("Respondent") mark ELLE BELLE. I submit this affidavit in support of Respondent's response to Petitioner's summary judgment motion.
2. The basis for Petitioner's motion is its allegation that Respondent's President Paramjit Singh committed fraud in obtaining registration of Respondent's mark ELLE BELLE by signing and submitting a trademark application stating that Respondent was using its mark ELLE BELLE in connection with women's, men's and children's clothing, namely, women's, men's and children's clothing, namely, shirts, blouses, dresses, evening wear, skirts, trousers, vests, jerseys, pants, pajamas, t-shirts, socks and stockings, singlets, corsets, garters, underpants, petticoats, hats, head scarves, neckties, raincoats, overcoats, great coats, bathing suits, sports overalls, wind resistant jackets and ski pants, although at

that time the mark was only being used in connection with women's clothing, namely, shirts, blouses, dresses, evening wear, skirts, jerseys, pants, corsets and head scarves.

3. In February of 2000, Balram Kakkar, Esq. a partner at my law firm, agreed to represent Respondent in obtaining a trademark application for Respondent's mark ELLE BELLE. Mr. Kakkar discussed the details of Respondent's mark ELLE BELLE with Mr. Singh. During this discussion, Mr. Singh informed Mr. Kakkar that Respondent was using the goods in connection with women's clothing, including shirts, blouses, dresses, evening wear, skirts, jerseys, pants, corsets and head scarves, and *would likely also use in the future* it in connection with men's and children's clothing, and additional women's clothing, including trousers, vests, pajamas, t-shirts, socks and stockings, singlets, corsets, garters, underpants, petticoats, hats, neckties, raincoats, overcoats, great coats, bathing suits, sports overalls, wind resistant jackets and ski pants. However, Mr. Kakkar misunderstood and was under the impression that Respondent was using its mark in connection with all of the goods mentioned by Mr. Singh, including those that Mr. Singh expressed only a future intent to use.
4. Following the conversation, Mr. Kakkar prepared an application representing the Respondent was using its mark ELLE BELLE in connection with all of the goods previously mentioned by Mr. Singh. When forwarding the application to Mr. Singh for his signature, Mr. Kakkar did not personally review the classification of goods listed therein with Mr. Singh, nor any other part of the application.
5. At Mr. Singh's deposition at which I was present, Mr. Singh readily testified that Respondent's mark ELLE BELLE had never been used in connection with men's or children's clothing. When I spoke with Mr. Singh to verify that he had understood the

question correctly, I discovered that Mr. Singh was under the impression that the trademark registration was obtained only in connection with women's clothing, namely, shirts, blouses, dresses, evening wear, skirts, jerseys, pants, corsets and head scarves

6. I have represented and communicated with Mr. Singh for almost two years. During this period, I have had difficulty communicating with him at times due to the language barrier. On numerous occasions during his deposition, opposing counsel and I had to repeat or rephrase the questions posed to Mr. Singh because he experienced difficulty understanding and responding to the questions posed. On several occasions I had to ask Mr. Singh to repeat his answers because it was apparent to me that that Mr. Singh was misstating his responses.
7. For the foregoing reasons I request that the Board deny Petitioner's summary judgment motion.

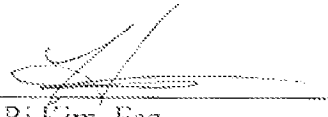

Hui Ri Kim, Esq.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Response to Petitioner's Motion for Summary Judgment, Affidavit of Paramjit Singh in Support of Respondent's Response to Petitioner's Summary Judgment Motion and Affidavit of Hui Ri Kim, Esq. in Support of Respondent's Response to Petitioner's Summary Judgment Motion is being served on May 26, 2006 by first class mail in a postage prepaid envelope, addressed as follows:

Perla M. Kuhn, Esq.
Kristin B. Whiting
One Battery Park Plaza
New York, NY 10004-1482
(212) 837-6000

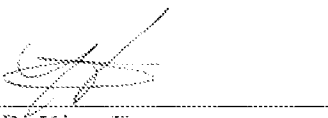
Dated: May 26, 2006
New York, New York

By: 
Hui Ri Kim, Esq.

CERTIFICATE OF ONLINE TRANSMISSION

I hereby certify that a copy of the foregoing Response to Petitioner's Motion for Summary Judgment, Affidavit of Paramjit Singh in Support of Respondent's Response to Petitioner's Summary Judgment Motion and Affidavit of Hui Ri Kim, Esq. in Support of Respondent's Response to Petitioner's Summary Judgment Motion is being transmitted online through the website of the United States Patent and Trademark Office on May 26, 2006.

Dated: May 26, 2006
New York, New York

By: 
Hui Ri Kim, Esq.